

### **REMARKS/ARGUMENTS**

This paper is in response to the Final Office Action mailed December 11, 2009 (“the Office Action”). Claims 1-2, 4, 6-14, 16-21 and 35 were pending in the present application. Claims 1-2, 4, 6-14, 16-21 and 35 stand rejected. Specifically, claims 1-2, 4, 6-14, 16-21 and 35 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Claims 1-2, 4 and 6-8 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Calabria et al., U.S. Pre-Grant Publication No. 2005/0137939 (hereinafter “Calabria”). Claims 9-14, 16-21 and 35 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Calabria in view of Georges R. Harik, U.S. Pre-Grant Publication No. 2005/0065806 (hereinafter “Harik”).

Claims 1, 7, 9-14, 16-18, 20-21 and 35 are amended herein, and claim 36 is newly added. Support for all amended claims can be found in the specification, and no new matter has been added by these amendments. In view of the following remarks, reconsideration of the rejected claims is respectfully requested.

#### **I. Examiner Interview**

A telephone interview was conducted with Examiner Yehdega Retta on Thursday, January 21, 2010 at 1pm Eastern Time (“the Examiner Interview”). Applicants were represented by Richard Dodson. During the interview, the claimed subject matter was discussed, as well as differences with respect to the cited art. Although no agreement was reached with respect to the claims, the Examiner offered suggestions to amend the claims to clearly distinguish them from the cited art. Applicants appreciate the Examiner’s helpful suggestions, and the claims have been amended in accordance with these suggestions.

## **II. Claims 1-2, 4, 6-14, 16-21 and 35 Are Allowable Under 35 U.S.C. § 112, 1<sup>st</sup>**

### **Paragraph**

Claims 1-2, 4, 6-14, 16-21 and 35 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement.

The Office Action alleges that the “each advertisement generator including a first algorithm for identifying search terms corresponding to an item to be advertised, a second algorithm for determining at least one item-specific visual element of an advertisement being created for the item, and a third algorithm for creating a link to information about the item” feature of independent claim 1 is not taught by the present specification. Applicants respectfully disagree with this characterization of the present specification. Nevertheless, to expedite prosecution, claim 1 is herein amended for clarity. It is respectfully submitted that independent claim 1 as amended is in compliance with 35 U.S.C. § 112, first paragraph. Accordingly, Applicants request that the Examiner withdraw the rejection of claim 1 under 35 U.S.C. § 112, first paragraph.

The Office Action does not give any reason for rejecting claims other than independent claim 1 and its dependent claims 2, 4 and 6-8 under 35 U.S.C. § 112, first paragraph. Indeed, the Office Action points out that the present specification, ¶ 0016, states “the different advertisement generators may use different algorithms to automatically generate ... advertisements.” Each of claims 2, 4, 6-14, 16-21 and 35 has been carefully reviewed for compliance with 35 U.S.C. § 112, first paragraph, and has been found to lie therein. Accordingly, Applicants request that Examiner withdraw the rejections of claims 2, 4, 6-14, 16-21 and 35 under 35 U.S.C. § 112, first paragraph.

## **III. Claims 1-2, 4 and 6-8 Are Allowable Under 35 U.S.C. § 103 Over Calabria**

Claims 1-2, 4 and 6-8 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Calabria. However, with regard to rejections under 35 U.S.C. § 103, the Office Action must provide evidence which as a whole shows that the legal determination sought to

be proved (i.e., the reference teachings establish a prima facie case of obviousness) is more probable than not. M.P.E.P. §2142. Accordingly, “the key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.” M.P.E.P. § 2142; see *KSR International Co. v. Teleflex, Inc.*, 550 U.S.398, 82 USPQ 2d 1385, 1395-97 (2007).

Furthermore, when rejecting the claims based on a combination of prior art elements according to known methods to yield predictable results, as the Office Action does in the present instance, the Office Action must articulate four factual findings. M.P.E.P. § 2143(A). First, there must be “a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference.” *Id.* Second, there must be “a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely performs the same function as it does separately.” *Id.* Third, there must be “a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable.” *Id.* Fourth, there must be articulation of “whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.” *Id.*

As shown below, the rejection of each claim 1-2, 4 and 6-8 under 35 U.S.C. § 103(a) in the Office Action is deficient in one or more of these respects and therefore fails to establish a prima facie case of obviousness. Each claim 1-2, 4 and 6-8 is therefore allowable under 35 U.S.C. § 103 for at least this reason. Accordingly, Applicants request that the rejection of each claim 1-2, 4 and 6-8 under 35 U.S.C. § 103 be withdrawn.

Independent Claim 1

Although independent claim 1, as amended, has not been examined, some remarks with respect to references cited in the Office Action are appropriate.

The Office Action cites Calabria, ¶ 0035-0040, 0044-0047 and 0109, as allegedly teaching the “advertisement manager” recited by independent claim 1. However, Calabria has several shortcomings in this respect. For example, claim 1 recites that the “advertisement manager ... selects one of the generated advertisement sets for submission to the advertisement placement service” on the condition that “an advertisement set is not currently submitted to the advertisement placement service for the set of keywords.” Calabria nowhere mentions checking for this condition and so does not teach or suggest each and every feature of independent claim 1 for at least this reason. Furthermore, claim 1 is amended herein to clarify and emphasize at least this distinction between independent claim 1 and Calabria. For example, claim 1 as amended recites that the “advertisement manager” detects the condition that “an advertisement set is currently submitted to the advertisement placement service for the set of keywords” and, in response, “selects one of the generated advertisement sets so as to avoid conflict with respect to the set of keywords of a currently submitted advertisement set.” At least for the purposes of applying Calabria to independent claim 1, Calabria does not teach that “generated advertisement sets” may “conflict with respect to the set of keywords of a currently submitted advertisement set,” and so cannot teach “select[ing] one of the generated advertisement sets so as to **avoid** conflict with respect to the set of keywords of a currently submitted advertisement set.”

Calabria fails to teach or suggest each and every feature of independent claim 1 for at least the above reasons. Thus the standing rejection of unamended claim 1 fails to establish a prima facie case of obviousness with respect to independent claim 1 as amended. Accordingly, Applicants request that the rejection of claim 1 under 35 U.S.C. § 103 be withdrawn.

Dependent Claims 2, 4 and 6-8

Claims 2, 4 and 6-8 depend from independent claim 1 and are therefore allowable at least for depending from an allowable claim. Furthermore, it is submitted that at least some of claims 2, 4 and 6-8 independently recite patentable subject matter. Additional reasons for the patentability of the dependent claims 2, 4 and 6-8 exist for at least this reason, and Applicants reserve, without prejudice, the right to provide these reasons at a later date.

**IV. Claims 9-14, 16-21 and 35 Are Allowable Under 35 U.S.C. § 103 Over Calabria In View Of Harik**

Claims 9-14, 16-21 and 35 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Calabria in view of Harik. However, as shown below, the rejection of each claim 9-14, 16-21 and 35 under 35 U.S.C. § 103(a) in the Office Action fails to establish a prima facie case of obviousness. Each claim 9-14, 16-21 and 35 is therefore allowable under 35 U.S.C. § 103 for at least this reason. Accordingly, Applicant requests that the rejection of each claim 9-14, 16-21 and 35 under 35 U.S.C. § 103 be withdrawn.

Independent Claim 9

Although independent claim 9, as amended, has not been examined, some remarks with respect to references cited in the Office Action are appropriate.

The Office Action cites Calabria, ¶¶ 0018-0019 and 0052-0054, as allegedly teaching the “subsequently selecting” step recited by independent claim 9. However, Calabria has several shortcomings in this respect. For example, claim 9 recites “subsequently selecting an advertisement set for placement with the advertisement placement service ... so that the selected advertisement set does not conflict with an advertisement set that is currently submitted to the advertisement placement service.” At least for the purposes of applying Calabria to independent claim 9, Calabria does not teach that “the selected advertisement set” may “conflict with an advertisement set that is currently submitted to the advertisement

placement service,” and so cannot teach “selecting an advertisement set for placement with the advertisement placement service ... so that the selected advertisement set does **not** conflict with an advertisement set that is currently submitted to the advertisement placement service.” Hence Calabria fails to teach or suggest each and every feature of claim 9 for at least this reason. Furthermore, independent claim 9 is amended herein to clarify and emphasize at least this distinction between claim 9 and Calabria. For example, independent claim 9 as amended recites that “the conflict ... [is] determined with respect to the set of keywords.”

Harik is not cited as teaching or suggesting, and in fact nowhere teaches or suggests, the “subsequently selecting” step as recited by independent claim 9 and read in light of the present specification. Hence also Harik is deficient in at least this respect, and thus cannot make up for the deficiencies in Calabria with respect to claim 9.

The proposed combination of Calabria and Harik does not teach or suggest each and every feature of independent claim 9 for at least the above reasons. Thus the standing rejection of unamended claim 9 fails to establish a prima facie case of obviousness with respect to independent claim 9 as amended. Accordingly, Applicants request that the rejection of claim 9 under 35 U.S.C. § 103 be withdrawn.

Dependent Claims 10-14 and 16-21

Claims 10-14 and 16-21 depend from independent claim 9 and are therefore allowable at least for depending from an allowable claim. Furthermore, it is submitted that at least some of claims 10-14 and 16-21 independently recite patentable subject matter. Additional reasons for the patentability of the dependent claims 10-14 and 16-21 exist for at least this reason, and Applicants reserve, without prejudice, the right to provide these reasons at a later date.

Independent Claim 35

Although independent claim 35, as amended, has not been examined, some remarks with respect to references cited in the Office Action are appropriate.

The Office Action rejects unamended claim 35 with the same language used to reject independent claim 9. However, a careful reading of claims 9 and 35 reveal that they are directed to distinct relationships between distinct entities, as is plain at least from the distinct language of the two claims. Accordingly, Applicants request that, in any subsequent action, independent claims 9 and 35 receive independent and thorough examinations.

The Office Action presumably cites Calabria, ¶ 0018-0019 and 0052-0054, as allegedly teaching the “subsequently selecting” program code recited by independent claim 35. However, Calabria has several shortcomings in this respect. For example, claim 35 as amended recites “subsequently selecting an advertisement set to be submitted for the set of keywords ... so as to avoid conflict with respect to the set of keywords of a currently submitted advertisement set.” At least for the purposes of applying Calabria to independent claim 35, Calabria does not teach that “an advertisement set” may “conflict with respect to the set of keywords of a currently submitted advertisement set,” and so cannot teach “selecting an advertisement set ... so as to **avoid** conflict with respect to the set of keywords of a currently submitted advertisement set.” Hence Calabria fails to teach or suggest each and every feature of independent claim 35 as amended for at least this reason.

Harik is not cited as teaching or suggesting, and in fact nowhere teaches or suggests, the “subsequently selecting” program code as recited by independent claim 35 and read in light of the present specification. Hence also Harik is deficient in at least this respect, and thus cannot make up for the deficiencies in Calabria with respect to claim 35.

The proposed combination of Calabria and Harik does not teach or suggest each and every feature of independent claim 35 for at least the above reasons. Thus the standing rejection of unamended claim 35 fails to establish a prima facie case of obviousness with

respect to independent claim 35 as amended. Accordingly, Applicants request that the rejection of claim 35 under 35 U.S.C. § 103 be withdrawn.

#### **V. Amendments to the Claims**

Unless otherwise specified or addressed in the remarks section, amendments to the claims are made for purposes of clarity, and are not intended to alter the scope of the claims or limit any equivalents thereof. The amendments are supported by the specification and do not add new matter. In addition, by focusing on specific claims and claim elements in the discussion above, applicants do not imply that other claim elements are disclosed or suggested by the references. In addition, any characterizations of claims and/or cited art are being made to facilitate expeditious prosecution of this application. Applicants reserve the right to pursue at a later date any other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by another prosecution. Accordingly, reviewers of this or any child or related prosecution history shall not reasonably infer that applicants have made any disclaimers or disavowals of any subject matter supported by the present disclosure.




**CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 206-467-9600.

Respectfully submitted,

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